REMARKS

In the Notice of Non-Compliant Amendment from the Examiner mailed January 29 2009, the Examiner correctly pointed out that the status identifier for claims 34 and 35 should be "currently amended".

The undersigned respectfully submits this entire amendment together with the remarks below.

REMARKS (PREVIOUSLY SUBMITTED)

Claims 1-9, 11, 20, 21, 23, 24, and 26-40 are pending in the present application. No claims have been added, cancelled or amended herein. Consequently, claims 1-9, 11, 20, 21, 23, 24, and 26-40 from the prior office action remain pending for the Examiner's consideration. Applicant acknowledges and appreciates the careful analysis of the claims and the cited references provided in the Office Action. The remarks below support applicant's assertion that these claims are statutory and distinguish over the prior art, and are therefore in condition for allowance.

35 U.S.C. § 101

Claims 20, 21, 23, and 24 are rejected under 35 U.S.C. § 101 as being directed to a stream of information. Paragraph 0024 of the present application is cited in support of this rejection. Applicant respectfully traverses. Initially, Claim 20 is directed to a <u>physical computer-</u>

readable storage medium having stored thereon a number of program codes. As such, the claim includes a limitation which would expressly prevent its invocation against mere streams of energy. Furthermore, as such, the claim is directed to "functional descriptive material" (as defined by MPEP 2106) recorded on a computer-readable medium. According to MPEP 2106: "[w]hen functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized." Thus, claim 20 satisfies the requirements of 35 U.S.C. § 101. Claims 21, 23, and 24 depend from claim 20, and therefore include the limitations found in claim 20, namely "physical computer-readable storage medium." Therefore, claims 21, 23, and 24 satisfy the requirements of 35 U.S.C. § 101 for the same reasons that claim 20 satisfies that statutory requirement

Furthermore, paragraph 0024 simply illustrates that the present invention may be embodiment in different forms of computer systems, cable television systems, wireless devices, and voice synthesized systems. That paragraph also demonstrates that the "output medium" discussed in the application may be one of a variety of types of devices, such as a Web client, retail point of sale, video game, television, or other digital media device. Respectfully, contrary to the assertion in the Office Action, paragraph 0024 does not say or imply that the invention may be embodied entirely in the content (i.e., a mere stream of information) flowing between such systems. Thus, claims 20, 21, 23, and 24 satisfy the requirements of 35 U.S.C. § 101.

<u>35 U.S.C. § 112</u>

Claims 1, 2, 34, and 35 are rejected under 35 U.S.C. § 112, as failing to comply with the written description requirement. The rejected claim language and the specific support therefor are discussed below. Applicant respectfully traverses the rejection of claims 1, 2, 34, and 35 under 35 U.S.C. § 112.

a) Claim 1 - "the selected product information includes data that is transmitted to the point of presentation from a server at a third network location in response to the user interaction." This limitation is discussed at paragraph 27, lines 5-8, and paragraph 37, lines 10-11, of the application as filed. ("The Seller's E-commerce server 132 then returns the product-related page 125 to the presentation device 34.")

b) Claim 2 - "the point of presentation comprises a presentation device at the second network location on which the product is presented." This limitation is discussed at paragraph 37, lines 10-11, of the application as filed. ("The Seller's E-commerce server 132 then returns the product-related page 125 to the presentation device 34.")

c) Claim 34 - "receiving product data from the presentation device". This limitation is discussed at paragraph 37, lines 12- 17. ("Program statements or executable codes of the "mboxes" cause the consumer/shopper's client to make a request to the Mbox server 140, <u>sending information about the product(s) displayed</u>. The "mboxes" may be configured such that identification of the consumer/shopper's client is <u>sent to the Mbox Server</u> 140 as well. The Mbox server 140 then <u>stores the received data</u> into the Merchandising Database 144." Emphasis added.) See also Figs. 5A and 5B.

d) Claim 35 - "presentation medium comprises device executable code that causes said presentation device to transmit said product data to said first network location". This limitation is discussed at paragraph 37, lines 12- 17. ("Program statements or executable codes of the "mboxes" cause the consumer/shopper's client to make a request to the Mbox server 140, sending information about the product(s) displayed. The "mboxes" may be configured such that identification of the consumer/shopper's client is sent to the Mbox Server 140 as well. The Mbox server 140 then stores the received data into the Merchandising Database 144." Emphasis added.)See also Figs. 5A and 5B.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116; MPEP 2163. The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117. Applicant respectfully asserts that the cited sections of the specification demonstrate that applicant was, indeed, in possession of the elements of the claims cited in the Office Action as not described in the specification (i.e., they are in fact described in the specification). Accordingly, applicant asserts that the rejection under 35 U.S.C. § 112 has been addressed and overcome, and respectfully requests reconsideration and removal of the rejection.

<u>35 U.S.C. § 102(a) – Claims 1-9, 11, 20, 21, 23, 24, 26-28, 30-33</u>

In the outstanding Office Action, the Examiner rejected claims 1-9, 11, 20, 21, 23, 24, 26-28, 30-36, and 38-40 as anticipated under 35 U.S.C. § 102(b) by Harrington (USP 5,895,454). For at least the following reasons, these rejections are respectfully traversed.

While a summary of the present invention has been provided in prior responses, and discussed with the Examiner, yet another brief summary is offered here, this time in the context of the Harrington reference in the hopes that any confusion about the various network locations and their role in the claimed method (discussed further below) is addressed. We begin with a model of three network locations. As a conceptual model for the context of the various entities involved in the present invention, and the communications taking place therebetween, the concept of network locations is introduced. Each location represents a device, such as a server, a computer workstation, and the like. Applicant provides here an association of such devices with those locations to provide the Examiner with a model for viewing the claimed invention. Accordingly, the first location can be equated with a merchandising server, the second location with a user's workstation, and the third location with a product seller's web business server.

According to this model, and claim 1 for example, at a user's request, product information is provided to the user's workstation (the second location) from the seller's web business server (the third location). Portions of this presented information with which the user interacts are identified by code operating at the user's workstation, and provided to the merchandising server (the first location). It is important to note that information to be provided to the merchandising server (the first location) is determined not at the seller's web business server (the third location), but rather at the user's workstation (the second location). Each

location is distinct, and one does not operate inside the confines of another. This is a fundamental difference between the claims and the Harrington reference.

The Harrington reference is directed to a commerce server which is a clearinghouse for vendors. Vendors are represented by the server, and a user interacts with the server to browse and make a purchase decision. The server keeps track of and handles (directly or indirectly) the purchases/sales at the vendor sites. The user does at some point interact with the vendor site, and that interaction is recorded (transaction notification) and sent to the commerce server. However, the interaction is tracked at the vendor site, and not the user's workstation. Stating this in terms of the locations discussed above, according to Harrington merchandising data is obtained by the first location (merchandising server) from the third location (vendor web business server), not, as claimed, from the second location (user's workstation). This is found in Harrington in a number of locations, such as col. 4, lines 36-38 (the vendor modified website software 24 transmits a transaction notification ... back to the database administration software 21.") Perhaps most helpfully, this is seen in Fig. 2 of Harrington, in which "VENDOR/PRODUCT INFO 32" is provide by "VENDOR 25" to "DATABASE ADMIN 21" and not by "USER 27".

This is significant for several reasons. First, there is a desire to unburden the vendor from significant modification of its website software, instead allowing the vendor to maintain essentially a standalone website ("there is no need to rebuild the seller's existing e-business systems or to perform direct integrations of the seller's existing source product database with third party software and services to obtain such merchandising data." Para. 29, lines 6-8. "Because the software program is not maintained by the subscriber business, and only minor modifications to existing Web-pages are needed, the cost of implementing the software can be minimized, and the software can be deployed in a very short time." Para. 33, lines 4-7.) This

should be compared with the statement from Harrington that "the actual functionality and effect of the purchase/order interface according to the present invention is critically different from a standalone website..." Col. 4, lines 31-33. See also the suggested merits of having the merchandising database administrator be responsible for creating the vendor website, including facilitating the exchange of data between the vendor and administrator. Col. 5, lines 15-21.

Second, while the present invention provides that certain information about a user interaction with a vendor site is provided to a merchandising server, the locations arrangement discussed above (as well as the multiple references to operating at the "point of presentation") makes clear that the merchandising server is independent of any transactions between the user and the vendor. This is to be contrasted with the disclosure of Harrington, in which the interaction with the vendor site is within the operation of the commerce site, and the purchase functions are controlled by the commerce server. ("The administration software 21 monitors the user's purchases and provides a real-time total or cost, goods ordered, etc. to the user. Col. 4, lines 46-48.)

There appears to be some confusion in the Office Action as to what applicant intends as the first, second, and third location. For example, at page 5, lines 18-20 of the Office Action appear to focus on the language "point of presentation", and suggests that it is the database 21 of Harrington. This overlooks the modifier that the point of presentation is "at a second network location" (in the example above, at the user workstation). It must be so, as the Office Action states that "the user 11 is at the second network location." Office Action, page 5, line 16. It also overlooks the claim language of claim 1 hereof, which states that the database is at the first network location. (Claim 1, lines 1-2.) The second network location cannot logically be both the user workstation and merchandising server, otherwise there would be no "populating a

merchandising product database" by "obtaining merchandising data at a second network location." That is, the first and second locations must be different. Therefore, the undersigned has presented the conceptual model that:

> the merchandising database is at the first network location, which receives data from the user workstation at the second network location, the user workstation receiving information from a product seller's (vendor's) web business server located at a third network location

in the hopes that any confusion about the various network locations and their relationship in the claimed method is removed.

With this explanation in mind, we turn to the claim language. Specifically, the following claim language is fundamentally different from the disclosure of Harrington, and accordingly renders the claims containing that language patentably distinct from the cited reference:

> "obtaining merchandising data ... presented ... at a second network location from a server at a third network location; and

> storing at least part of the obtained merchandising data ... at the first network location..."

Claim 1, lines 3-9. Also, similar language is found in claim 8, lines 3-7; claim 20, lines 4-12; claim 26, lines 12; and claim 34, lines 3-10. That is, while the present application claims that the merchandising server obtains the product data from the user workstation, Harrington teaches that it obtains that data from the vendor site (and does not suggest it could be otherwise). Furthermore, by their dependence on these claims, the remainder of the claims in the present application also contain the quoted language. Therefore, those claims must also be patentably distinct from Harrington.

Further still, claim 28 makes one important differentiation from Harrington explicit: "the selected data is communicated from the source product databases to the merchandising product database by way of the second network location and without requiring a direct data transfer between the source product databases at the third network location and the merchandising product database at the first network location". (Claim 26, lines 7-12.) This further strengthens the difference between the claimed invention (data provided by user to merchandising server) and the disclosure of Harrington (data provided by vendor to merchandising server). Claims 27-30 depend from claim 26, and therefore also contain this explicit differentiation from Harrington.

It is well established that "[a] claim is anticipated [under 35 U.S.C. § 102(b)] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." <u>Verdegaal Bros. v. Union Oil Co. of California</u>, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least the reasons that Harrington fails to teach or suggest the merchandising database obtaining data from the user workstation, as opposed to from the vendor server, claims 1-9, 11, 20, 21, 23, 24, 26-28, 30-36, and 38-40 are clearly allowable over the Harrington reference. Reconsideration, removal of the rejection, and allowance of these claims is respectfully requested.

It should finally be noted that while applicant appreciates the time taken to focus attention on those portions of the Harrington reference the Examiner asserts teaches the specific elements of the claims, doing simply by referring to a relatively large number of lines in the reference does not clearly point out the presence of the specific claimed element. For example, claim 3 includes the limitation "the obtaining step comprises obtaining data about the product directly from the point of presentation of the product ..." (Claim 3, line1-3.) It is

asserted that this is shown in col. 4, lines 35-50, yet that section seems limited to only those products which are purchased ("[i]f a user activates the 'purchase' button...") The section otherwise seems not to disclose details about obtaining data from the point of presentation. Similarly, claims 4 contains the limitation "wherein the merchandising product database does not have information related to the product stored therein prior to the storing step." (Claim 4, lines 1-3.) Again, the only reference in the Office Action to where this is shown in Harrington is at Col. 4, lines 35-50. However, the undersigned does not find a reference to this limitation in the cited passage of Harrington. To be clear, applicant's concern here is not just as to claims 3 and 4, but as to claims 2-7, 9, 11, 21, 23, 24, 26-28, 30-33, 35-36, and 38-40.

The burden is on the Patent Office in the first instance to clearly explain how and where the cited reference discloses the claimed invention. See Ex parte Levy, 17 U.S.P.Q.2d 1461 (BPAI 1990). The Examiner has not met this burden with mere pointers to sections of the reference. Such pointers seem more in the spirit of "a conclusion, rather than a reason" (Ex parte Garrett, 1986 Pat. App. LEXIS 8, 4 (EPAI 1986)), and applicant respectfully requests further specificity in any further rejection of the claims.

35 U.S.C. § 102(a) – Claims 34-36 and 38-40

Claim 34 has been amended to more clearly point out that product data is transmitted from a third network location (e.g., a vendor web-site) to a presentation device located at a second network location, and then the product data is transmitted from the presentation device to the first network location to be stored at the merchandizing product database. The undersigned wishes to thank the Examiner for suggesting the claim amendments during the

telephonic interview on July 9, 2008. Support for the amendment could be found all over the entire specification. For example, paragraph [0045] of the present application provides the following description:

[0045] A product data collection process according to an embodiment of the invention begins with a consumer/shopper operating a client (e.g., Microsoft Internet Explorer) on a presentation device 34 to generate a request for product information from the Seller's E-Commerce Server 132. Upon receiving the request, the Seller's E-Commerce Server 132 may retrieve data from the various databases 120 containing product information, and may produce a product-related page 125 containing the product's information or a strictly HTML page. Significantly, the product-related page 125 generated by the Seller's E-Commerce Server 132 contains "mboxes", which consist of program statements or executable codes and which will be described in greater detail below. The Seller's E-Commerce Server 132 then returns the product-related page 125 to the presentation device 34. The consumer/shopper's client renders the returned the product-related page 125, including the embedded "mboxes". Program statements or executable codes of the "mboxes" cause the consumer/shopper's client to make a request to the Mbox Server 140, sending information about the product(s) displayed. The "mboxes" may be configured such that identification of the consumer/shopper's client is sent to the Mbox Server 140 as well. The Mbox Server 140 then stores the received data into the Merchandising Database 144.

Response to Office Action

As pointed out earlier, the teaching of Harrington is limited to sending transactional records from the vendor web-site back to the database. Accordingly, the undersigned respectfully solicit the allowance of claim 34 over Harrington.

Claim 35 has been amended to include the limitation that the "presentation medium comprises device executable code that causes sais presentation device to transmit said product data to said first network location contemporaneously with rendering of said presentation medium on said presentation device." Support for the amendment can also be found throughout the entire specification. For example, in paragraph [0028] of the present application the following description is provided:

> [0028] According to another embodiment of the invention, the point of presentation or sale may refer to the time at which products are presented. According to one embodiment, the invention collects merchandising data when the customer browses an interactive catalog. Thus, merchandising data is collected contemporaneously with product presentation or sale regardless of where the merchandising data is collected. For instance, the merchandising data may be collected from the seller's server that produces Web-pages. The merchandising product data is then stored within a database, which may not have any prior data about the product(s) displayed.

Support of the amendment may also be found in the original claims 5, 11 and 17. Exemplary executable code for an "mbox" 126 which is executed by a client device when the web-page is rendered and which causes a client device to transmit data to the mbox server 140 can be found in the Appendix of the present application.

Response to Office Action

The Harrington reference does not contain any reference to executable code embedded or somehow included in a presentation medium. Furthermore, transaction records are sent when the user presses a "purchase button", which presumably occurs after the rendering of said presentation medium on said presentation device. Accordingly, the undersigned respectfully solicit the allowance of claim 35 over Harrington.

35 U.S.C. § 103(a)

Finally, claims 29 and 37 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Harrington in view of Musgrove. Applicant respectfully traverses this rejection, and requests reconsideration and allowance of claims 29 and 37.

Applicant has dispositively shown that Harrington lacks a teaching of a merchandising database obtaining product data from a user workstation as opposed to a vendor site. In applicant's prior response (incorporated by reference herein), it was shown that there are two fundamental limitations not found in Musgrove:

(1)   there is no "obtaining merchandising data related to a product from selected product information presented at a point of presentation of the product at a second network location, the obtaining step comprising acquiring said selected product information from at least one user interaction at said second network location with a presentation medium obtained from a server at a third network location"; and

(2)   populating a merchandising database with "selected product information from at least one user interaction".

That is, applicant has previously shown that Musgrove fails to teach a merchandising server obtaining data from a user workstation as opposed to a vendor site. Since neither Harrington nor Musgrove teach such a limitation, and since claims 29 and 37 contain such a limitation (by their dependence on claims 26 and 34, respectively), the combination of Harrington and Musgrove cannot teach or suggest each element of claims 29 and 37. The Examiner has made no suggestion that such limitations are provide elsewhere such as within the scope of one or ordinary skill in the art.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). As there is at least one element not found to be shown in the cited reference, the obviousness of claims 29 and 37 has not be sufficiently shown. Therefore, the rejection of claims 29 and 37 should be reconsidered and withdrawn.

Importantly, while applicant has focused on a number of the common limitations from the base claims as distinguishing those claims from the cited reference(s), there are additional limitations present in the base claims which may further distinguish those claims from the cited reference(s). Therefore, the fact that those additional limitations are not specifically discussed herein is not to be read as implying that those discussed herein are the exclusive set of such differentiating limitations. Rather, applicant has selected several differentiating limitations and limited the discussion thereto in the interest of brevity, and reserves the opportunity to discuss those limitations further in subsequent correspondence regarding this case, if necessary.

Finally, each of the dependent claims in the present application provide their own additional limitations which may form the basis for distinguishing the reference(s), although such limitations are not explicitly addressed herein. Thus, applicant reserves the right to argue the differences between any and all specific dependent claim limitations and the cited reference(s) for a later date, if necessary.
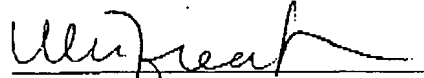
Conclusion

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration and issuance of a formal Notice of Allowance for this application in light of the amendments and remarks provided above is respectfully requested.

By action taken here, Applicant in no way intends to or causes any surrender of any subject matter or range of equivalents beyond that strictly required to patentably distinguish the claimed invention as a whole over the prior art. Applicant expressly reserves without dedication all such subject matter and equivalents that may fall in the range between Applicant's literal claim recitations and combinations taught or suggested by the prior art. Furthermore, distinctions between the claims and cited references in addition to those made herein may exist. Thus, applicant also reserves the right to highlight some or all of those additional distinctions at a later date, if appropriate.

If the Examiner believes that a telephone conference would expedite prosecution and allowance of this application, please telephone the undersigned at 650-969-8300.

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